

ESTTA Tracking number: **ESTTA528330**

Filing date: **03/22/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	DRL Enterprises, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2301 Ravine Way Glenview, IL 60025 UNITED STATES		

Attorney information	Antony J. McShane Neal, Gerber & Eisenberg LLP 2 North LaSalle Street, Suite 1700 Chicago, IL 60602 UNITED STATES amcshane@ngelaw.com, jcohen@ngelaw.com, temmanuelson@ngelaw.com Phone:312.269.8000
----------------------	--

Applicant Information

Application No	85606469	Publication date	03/05/2013
Opposition Filing Date	03/22/2013	Opposition Period Ends	04/04/2013
Applicant	New Leaf Systems, LLC 468 N. Camden Drive Beverly Hills, CA 90210 UNITED STATES		

Goods/Services Affected by Opposition


Class 034. All goods and services in the class are opposed, namely: Cigar and cigarette boxes; Cigarette cases; Electronic cigarettes
--


Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1481006	Application Date	04/07/1986
Registration Date	03/15/1988	Foreign Priority Date	NONE
Word Mark	1.0 POINT		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 1985/12/30 First Use In Commerce: 1985/12/30 CIGARETTE PAPERS

U.S. Registration No.	1328866	Application Date	04/08/1982
Registration Date	04/02/1985	Foreign Priority Date	NONE
Word Mark	1.25 POINT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 1977/05/20 First Use In Commerce: 1977/05/20 Cigarette Papers		

U.S. Registration No.	1331207	Application Date	04/08/1982
Registration Date	04/16/1985	Foreign Priority Date	NONE
Word Mark	1.5 POINT		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 034. First use: First Use: 1976/04/09 First Use In Commerce: 1976/04/09 Cigarette Papers
----------------	---

Related Proceedings	Opposition No. 91208195
---------------------	-------------------------

Attachments	73592167#TMSN.gif (1 page)(bytes) 73358902#TMSN.gif (1 page)(bytes) 73358876#TMSN.gif (1 page)(bytes) Notice_of_Opposition_re_O1.pdf (4 pages)(12570 bytes) EXHIBIT A re O1.pdf (7 pages)(69735 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Antony McShane/
Name	Antony J. McShane
Date	03/22/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No.
85/606,469 for O1

Published in the Official Gazette
on March 5, 2013

DRL ENTERPRISES, INC.

Opposer,

v.

NEW LEAF SYSTEMS, LLC

Applicant.

NOTICE OF OPPOSITION

This Notice of Opposition is submitted in the matter of applications of New Leaf Systems, LLC to register the mark O1, namely Application Serial No. 85/606,469 based upon its intent to use the mark in connection with “cigar and cigarette boxes; cigarette cases; electronic cigarettes” in International Class 34. DRL Enterprises, Inc., a Delaware Corporation, having a place of business at 2301 Ravine Way, Glenview, Illinois, 60025, believes that it would be damaged by the registration and therefore opposes the same.

The grounds for Opposition herein are as follows:

1. For many years, and long prior to the acts of Applicant herein alleged, DRL Enterprises Inc., its affiliates and predecessors (“DRL”) have been engaged, *inter alia*, in the manufacture, distribution and sale of smoker’s articles, including cigarette rolling papers. Such goods are distributed to consumers across the United States through tobacco shops, drugstores, tobacco outlets, convenience and other retail stores.

2. Since the 1970's, DRL has devoted substantial resources, time and effort in developing, marketing and distributing its cigarette papers under its family of marks comprising 1.0, 1.25, and 1.5 (the "Number Marks").

3. As a result of its consistent and successful efforts to promote, distribute and sell cigarette papers under and in connection with the Number Marks, DRL has developed considerable consumer recognition and goodwill in the Number Marks, which are now among DRL's most valuable assets. To protect its rights in the marks, DRL has obtained federal registrations for the marks "1.0," "1.25" and "1.5" for use in connection with cigarette papers in International Class 34 and which are incontestable pursuant to 15 U.S.C. § 1065. (See copies of U.S. Patent and Trademark Office records for Registration Nos. 1,481,006, 1,328,866 and 1,331,207, attached hereto collectively as Exhibit A).

4. On April 24, 2012, well after DRL began its use of, and developed its rights in, its Number Marks and after DRL's Number Marks were registered in the U.S. Patent and Trademark Office, Applicant filed an application to register the mark O1 in connection with "cigar and cigarette boxes; cigarette cases; electronic cigarettes" in International Class 34, namely Application Serial No. 85/606,469.

5. The O1 mark that Applicant seeks to register is likely to cause confusion or mistake, or to deceive purchasers, in that purchasers would be likely to believe Applicant's goods are DRL's goods, or are in some way legitimately connected with, sponsored by or approved by DRL in violation of 15 U.S.C. § 1052(d). Applicant's registration of the O1 mark would, therefore, result in damage to DRL, and on this basis, DRL opposes registration of Applicant's mark.

WHEREFORE, DRL requests that the registration sought by Applicant be refused and that this Notice of Opposition be sustained.

DRL Enterprises, Inc. requests that the requisite filing fee of \$300.00 be charged to the deposit account of Neal, Gerber & Eisenberg, Account No. 502261.

Respectfully submitted,

Date: March 22, 2013

By: /Antony J. McShane/
One of the Attorneys for DRL Enterprises, Inc.

Antony J. McShane
Jessica Rissman Cohen
Neal, Gerber & Eisenberg LLP
Two North LaSalle Street
Chicago, Illinois 60602-3801
(312) 269-8000

CERTIFICATE OF SERVICE

I, Jessica Rissman Cohen, an attorney, states that, pursuant to 37 CFR §§ 2.101, 2.111, and 2.119, I caused a true and correct copy of the foregoing Notice of Opposition to be served upon:

Amy E. Burke
Conkle, Kremer & Engel, PLC
3130 Wilshire Boulevard, Suite 500
Santa Monica, California 90403-2351

via U.S. Mail, first class, postage-prepaid, on March 22, 2013.

/Jessica Rissman Cohen /
Jessica Rissman Cohen

NGEDOCS: 2067143.1

EXHIBIT A



Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Mar 22 05:02:47 EDT 2013

TESS HOME | NEW USER | STRUCTURED | FREE FORM | BROWSE DICT | SEARCH OG | BOTTOM | HELP

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

(Use the "Back" button of the Internet Browser to return to TESS)



Word Mark	1.0 POINT
Goods and Services	IC 034. US 008. G & S: CIGARETTE PAPERS. FIRST USE: 19851230. FIRST USE IN COMMERCE: 19851230
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	73592167
Filing Date	April 7, 1986
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	April 14, 1987
Registration Number	1481006
Registration Date	March 15, 1988
Owner	(REGISTRANT) REPUBLIC TOBACCO INC. CORPORATION ILLINOIS 5100 NORTH RAVENSWOOD CHICAGO ILLINOIS 60640 (LAST LISTED OWNER) DRL ENTERPRISES, INC. CORPORATION ASSIGNEE OF DELAWARE 5100 NORTH RAVENSWOOD CHICAGO ILLINOIS 60640
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	Antony J. McShane
Prior Registrations	1328866;1331207
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "1.0" APART FROM THE MARK AS SHOWN
Type of Mark	TRADEMARK

Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20080305.
Renewal	1ST RENEWAL 20080305
Live/Dead Indicator	LIVE

[TESS HOME](#)

[NEW USER](#)

[STRUCTURED](#)

[FREE FORM](#)

[BROWSE DICT](#)

[SEARCH OG](#)

[TOP](#)

[HELP](#)

[HOME](#)

[SITE INDEX](#)

[SEARCH](#)

[eBUSINESS](#)

[HELP](#)

[PRIVACY POLICY](#)

**United States Patent and Trademark Office**
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

**United States Patent and Trademark Office**
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Mar 22 05:02:47 EDT 2013

TESS HOME

NEW USER

STRUCTURED

FREE FORM

BROWSE DICT

SEARCH OG

BOTTOM

HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

TSDR

ASSIGN Status

TTAB Status

(Use the "Back" button of the Internet Browser to return to TESS)




Word Mark	1.25 POINT
Goods and Services	IC 034. US 008. G & S: Cigarette Papers. FIRST USE: 19770520. FIRST USE IN COMMERCE: 19770520
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	73358902
Filing Date	April 8, 1982
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 28, 1984
Registration Number	1328866
Registration Date	April 2, 1985
Owner	(REGISTRANT) Republic Tobacco, Inc. CORPORATION ILLINOIS 5100 N. Ravenswood Chicago ILLINOIS 60640 (LAST LISTED OWNER) DRL ENTERPRISES, INC. CORPORATION DELAWARE 2301 RAVINE WAY GLENVIEW ILLINOIS 60025
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	NICOLE M. WALKER
Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20050524.
Renewal	1ST RENEWAL 20050524
Live/Dead Indicator	LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[| HOME](#) [| SITE INDEX](#) [| SEARCH](#) [| eBUSINESS](#) [| HELP](#) [| PRIVACY POLICY](#)

**United States Patent and Trademark Office**
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

**United States Patent and Trademark Office**
[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Fri Mar 22 05:02:47 EDT 2013

TESS HOME

NEW USER

STRUCTURED

FREE FORM

BROWSE DICT

SEARCH OG

BOTTOM

HELP

Logout

Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

TSDR

ASSIGN Status

TTAB Status

(Use the "Back" button of the Internet Browser to return to TESS)



Word Mark	1.5 POINT
Goods and Services	IC 034. US 008. G & S: Cigarette Papers. FIRST USE: 19760409. FIRST USE IN COMMERCE: 19760409
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Serial Number	73358876
Filing Date	April 8, 1982
Current Basis	1A
Original Filing Basis	1A
Published for Opposition	August 28, 1984
Registration Number	1331207
Registration Date	April 16, 1985
Owner	(REGISTRANT) REPUBLIC TOBACCO INC. CORPORATION ILLINOIS 5100 NORTH RAVENSWOOD CHICAGO ILLINOIS 60640 (LAST LISTED OWNER) DRL ENTERPRISES, INC. CORPORATION DELAWARE 2301 RAVINE WAY GLENVIEW ILLINOIS 60025
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	NICOLE M. WALKER
Type of Mark	TRADEMARK
Register	PRINCIPAL-2(F)
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20050524.
Renewal	1ST RENEWAL 20050524
Live/Dead Indicator	LIVE

[TESS HOME](#) [NEW USER](#) [STRUCTURED](#) [FREE FORM](#) [BROWSE DICT](#) [SEARCH OG](#) [TOP](#) [HELP](#)

[| HOME](#) [| SITE INDEX](#) [| SEARCH](#) [| eBUSINESS](#) [| HELP](#) [| PRIVACY POLICY](#)